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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,515

Applicant(s)

CARFI ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Notice to Applicant

1. This communication is in response to the amendment filed 21 August 2006. Claims 11-13, 16, 18 have been amended. Claims 1-20 remain pending.

Claim Rejections - 35 USC § 112

2. The rejection of claim 18 under 35 U.S.C. 112, second paragraph, for being indefinite is hereby withdrawn due to the amendment filed 21 August 2006.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundegren, U.S. Patent Application Publication Number 2002/0143584 and further in view of Kelly et al., U.S. Patent Number 5, 806, 042 for substantially the same reasons given in the previous Office Action (paper number 05122006). Further reasons appear hereinbelow.

(A) Claim 13 has been amended to include the recitation of

- ♦ "automatically... software module," in line 7.

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As per newly amended claim 13, Lundegren and Kelly teach a method as analyzed and discussed in the previous Office Action (paper number 05122006) further comprising setting forth results of a financial analysis automatically performed by a software module (Lundegren; Figures 1-6, paragraphs [0027], [0029], [0055]-[0061], [0065]).

The remainder of claim 13 is rejected for the same reasons given in the prior Office Action (paper number 05122006, section 4, page 7), and incorporated herein.

The motivations for combining the respective teachings of Lundegren and Kelly are as given in the prior Office Action (paper number 05122006), and incorporated herein.

(B) The amendments to claims 11-12, 16, 18 appear to have been made merely to correct minor typographical or grammatical errors and to correct rejections under 35 U.S.C. 112, second paragraph. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 05122006, section 5, pages 5-8), and incorporated herein.

(C) Claims 1-4, 6-10, 14-15, 17, 19-20 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 05122006, section 5, pages 3-8), and incorporated herein.

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5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lundegren, U.S. Patent Application Publication Number 2002/0143584 and Kelly et al., U.S. Patent Number 5,806,042, as applied to claim 1 above, and further in view of Lange, U.S. Patent Application Publication Number 20020/0147670 for substantially the same reasons given in the previous Office Action (paper number 05122006). Further reasons appear hereinbelow.

(A) Claim 5 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 05122006, section 6, pages 8-9), and incorporated herein.

Response to Arguments

6. Applicant's arguments filed 21 August 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 21 August 2006.

(A) At pages 8-11 of the 21 August 2006 response, Applicant argues that the claimed features of the application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the newly added features, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of the cited references based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC §103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 05122006), and incorporated herein. In

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particular, Examiner notes that the limitations of "[...] automatically performed by a software module [...]" are taught by the cited references (see, for example, (Lundegren; Figures 1-6, paragraphs [0027], [0029], [0055]-[0061], [0065]). Examiner interprets Lundegren's teachings of "[t]he computer network 1 is preferably conventional for internet applications [reads on "software modules"] and includes a database 5, a server 6 and a firewall 8 which are selectively accessible through the internet 9 from computers 10 and 11 of end users. As used herein the database 5, the server 6, firewall 8 and software run thereon to store, provide access to and manipulate data stored in the database 5 or on the server 6 and firewall 8, may collectively be referred to as a server or system server 15. The system server 15 is generally assembled, operated, maintained and connected to the internet 9 ... [...] ... end users use web browsers on their computers 10 or 11 to connect to the system server 15. The system server 15 responds to requests and commands [reads on "automatically"] received from the end user's browser, to generate pages of an interactive ... [...] ... website through which part of the methodology of the present invention may be practiced" (Lundegren; paragraph [0027]) as teaching "automatically performed by a software module," as recited in amended claim 13.

With respect to Applicant's argument on page 9, lines 11-13 and 17-19 of the 21 August 2006 response that the Lundegren reference "does not teach that the analysis is performed by a software module run on a server that is connected to a user terminal receiving inputs from and providing outputs to the users ..." and "it is not explicitly taught that the analysis is performed automatically, as would be the case if the analysis were performed by a software module" it is respectfully submitted that Applicant ignores the clear and unmistakable teachings of Lundegren

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with respect to teaching "[t]he system server 15 is generally assembled, operated, maintained and connected to the internet 9 ... [...] ... end users use web browsers on their computers 10 or 11 to connect to the system server 15. The system server 15 [i.e. "software"] responds to requests and commands [reads on "automatically"] received from the end user's browser [reads on "inputs from ... users"], to generate pages of an interactive ... [...] ... website [reads on "outputs to ... users"] through which part of the methodology of the present invention may be practiced" (Lundegren; paragraph [0027]) (emphasis added). Examiner interprets these teachings as reading on the argued limitations.

With respect to Applicant's argument on page 10, paragraph 1 of the 21 August 2006 response that the Kelly reference "does not describe a software module performing analysis of reinsurance options based on inputs from a terminal," Examiner respectfully notes that it was the Lundegren reference that was used to reject these limitations (Lundegren; Figure 1, Figure 2, paragraphs [0009], [0011], [0026]- [0027], [0031]-[0032], [0041]-[0043], [0049], [0061]).

With respect to Applicant's argument on page 10, paragraph 2 to page 11, paragraph 1 of the 21 August 2006 response, that the combined applied references fail to teach "a software module automatically performing analysis on data inputs of the nature of those claimed by claim 13," these arguments have been discussed earlier in this Office Action.

At pages 9-11 of the 21 August 2006 response, Applicant argues the applied references separately and argues each of the references individually. In response to Applicant's arguments

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against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In particular, as demonstrated in the rejections of claims 1-12 and 14-20 and of newly amended claim 13 above and in the previous Office Action (paper number 05122006), the combined cited references of Lundegren, Kelly, and Lange, teach a software module run by the server computer (Lundegren; Figure 2, paragraph [0027]) for performing a financial analysis of proposed captive reinsurance options based upon inputs received at the terminal from a user (Lundegren; Figure 2, paragraphs [0009]-[0011], [0031]-[0032], [0041]-[0043], [0049], [0061]), the terminal displaying results of the financial analysis to the user automatically performed by a software module based on the inputted data (Lundegren; Figures 1-6, paragraphs [0009]-[0011], [0027], [0029], [0055]-[0061], [0065]), (Kelly; column 6, lines 24-41).

Consequently, it is respectfully submitted that contrary to Applicant's allegations, the features that Applicant disputes are clearly within the teachings of the applied references and that Applicant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

October 24, 2006


Primary C. LUKE GILLIGAN
PATENT EXAMINER